## REMARKS

In the Office Action mailed January 5, 2005, claims 8-18 and 22 were rejected under 35 U.S.C. §112, and claims 1-7, 19-21 and 23-24 were rejected under 35 U.S.C. §102(b). After a careful review of the pending Office Action and the cited references, Applicant respectfully requests reconsideration in view of the following remarks.

As set forth, claims 1, 8, 16 and 19 have been amended, and the language in claim 22 has been returned to its original format fixing the typographical error within the previous Office Action response.

### I. 35 U.S.C. § 112 Claim Rejections

#### A. First Paragraph Claim Rejections

Claims 8-15 were rejected 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Office asserted that the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Office asserted that the specification does not have enough support for the claimed "database within the player, the database provides a list of content files that includes files not existing on the player." (Office Action, 1.05.05, p. 3). Applicant traverses.

Claim 8 recites "accessing a database within the media player, wherein the database provides a list of content files that includes identifiers of files not existing on the media player, the selection of content files being associated with content files in the list," "connecting the media player to a source of content," and "executing at least one predefined rule to perform at least one operation on at least one content file associated with the selection of content files."

The specification describes this subject matter at least on page 4, lines 24-26 and page 5, lines 3-9. For example, "where the user has selected a play list on the media player, the player would then identify those files listed in the play list not currently resident on the player. The player would then pull those files to the player storage when the player is connected to the source of content." (p. 4, line 25 to p. 5, line 1). The specification continues at page 5, line 3 through line 19 to discuss an example where a user inputs a file identifier, such as a play list name, and then the media player determines which files are already on the media player. If the files are not on the media player, the player will "identify a task that needs to be performed when the player is next connected to the source of content." (p. 5, lines 10-11). For example, when the media player is next connected to the source of content, the media player may download the files that the user had pre-selected for download. As such, Applicant submits that claims 8-15 are fully supported by the specification as originally filed.

## B. Second Paragraph Claim Rejections

Claims 8-18 and 22 were also rejected 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office asserted that it is not understood how the database within the player provides a list of content files that includes files not existing on the player, or how the selection of content files after being added to the database within the player does not exist on the player as in claims 8 and 16.

Claim 8 recites "accessing a database within the media player, wherein the database provides a list of content files that includes identifiers of files not existing on the media player, the selection of content files being associated with content files in the list," "connecting the

media player to a source of content," and "executing at least one predefined rule to perform at least one operation on at least one content file associated with the selection of content files."

Claim 16 recites "adding the selection of content files to a database within the portable media player, wherein the database provides a list of content files associated with the selection of content files," "determining if any content files in the list of content files do not exist on the portable media player," "connecting the portable media player to a source of content," and then "adding to the portable media player any content files from the list of content files not already existing on the portable media player."

Within claims 8 and 16, the "list of content files" refers to identifiers of the content files organized in some manner (e.g., in a list), and not to a collection of the files themselves. For example, on page 3, lines 17-20, the specification describes that "the content database tracks relationships between the content selection and the content files. For example, a file Music1 may have an identifier that indicates it is part of the content selection, or play list, named 'Play List A.'" Further, on page 4, lines 10-15, the specification describes that the "user may create play lists, which are lists of files to be played grouped together under a list identifier."

Thus, the database within the media player provides a list of content files, which includes identifiers referring to certain files, and some of these certain files may not currently exist on the media player. Applicant submits that claims 8 and 16 are fully supported by the specification as originally filed.

## II. 35 U.S.C. § 102(b) Claim Rejections

### A. Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rose et al., U.S. Patent No. 5,752,244 (Rose).

To anticipate a claim, each and every element set forth in the claim must be found in a single reference. (MPEP § 2131). Further, "[t]he identical invention must be shown in as

complete detail as contained in the ... claims." (MPEP § 2131). Applicant submits that Rose does not teach a media player including "a content database for storing the at least one organizational task to be executed upon connection of the player to a content source," as in claim 1.

Rose does not teach a media player including a content database, which manages relationships between content selections and content files, that is separate from a media or content source. For example, claim 1 recites that, a user can "make content selections," and store "at least one organizational task to be executed *upon connection of the media player to a content source*" (e.g., upon connection to a content source, the media player can pull content files within the play list from the content source to the player (Specification, p. 4 line 25 to p. 5 line 10)). (Emphasis added).

In contrast, Rose teaches checking-out or downloading multimedia assets from a system by connecting a client computer through a network to a server, and then selecting assets to download. Rose does not teach pre-selection of content to download on the media player, e.g., such as "a content database" on the media player "for storing the at least one organizational task to be executed upon connection of the player to a content source," as in claim 1.

In particular, Rose teaches that once a connection is formed with the server, the user can then access the multimedia asset management program. During login, once the user's record is found, the server returns the list of projects to which the user is currently assigned. This information is stored on the server. (Col. 14, lines 19-35). Rose does not teach "a content database" on the media player "for storing the at least one organizational task to be executed upon connection of the player to a content source," as in claim 1. Thus, since Rose does not teach all limitations of pending claim 1 in as complete detail as contained in Applicant's currently pending claims, then Rose fails to anticipate claims 1-7.

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The Office asserted that the claimed organizational task to be executed upon connection of the player to a content source is met by the tasks of check-in and check-out as shown in Rose, and that the task is executed upon connection to the content source and must be stored on the database as claimed. (Office Action, 1.05.05, p. 2). Applicant traverses. Simply because the task can be executed upon connection to the content source does not mean that the task itself, or information causing the machine to execute the task, is stored on the database prior to connecting the machine to the content source. The client computer taught in Rose does not store tasks to be executed, as recited in claim 1. Rather, upon connection to a server, a user may then execute tasks in real-time, such as selecting assets to download. Rose does not teach pre-selecting content to download onto the media player, e.g., such as "a content database" on the media player "for storing the at least one organizational task to be executed upon connection of the player to a content source," as in claim 1.

In addition, the Office asserted that limitations indicating that the database is separate from a media or content source are not reflected in the claim language. Applicant traverses. Claim 1 recites "a content database for storing the at least one organizational task to be executed upon connection of the media player to a content source," and thus the database must be separate from the content source. In contrast, Rose does not teach a database for storing tasks that is separate from the content source. Within Rose, the content source includes both lists of content and the content files that are accessed by the user.

Further, the Office asserted that the limitation regarding pre-selection of content is not reflected in the claim language. Applicant traverses. Claim 1 requires "a user to make content selections," and "a content database for storing the at least one organizational task to be executed upon connection of the media player to a content source," and thus the selections are first defined

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by the user, and secondly tasks are performed only upon connection of the media player to a content source. As a result, content is pre-selected for download, for example.

**B. Claims 19-21 and 23-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lamkin, U.S. Patent Application document number 2004/0220926 (Lamkin).**

Applicant submits that Lamkin does not teach an article containing machine-readable code that, when executed, causes a machine to "add the selection of content files to a list of content files on a database within the machine," "connect the machine to a source of content," and "execute predefined rules to perform at least one operation on content files associated with the selection of content files after connection to the source of content," as in claim 19.

Lamkin teaches a media player that can operate with or without a connection to the Internet. When the media player is connected to the Internet, entities and collections not locally stored on the media player are available for display. Entities and collections can be downloaded and stored locally or they can be streamed to the media player. (Lamkin, 0119).

Applicant contends that Lamkin does not teach a machine to "add the selection of content files to a list of content files on a database within the machine," "connect the machine to a source of content," and then "execute predefined rules to perform at least one operation on content files associated with the selection of content files after connection to the source of content," as in claim 19. In contrast, Lamkin teaches connecting a player to the internet, or any other content source, and further allowing a user to then select files for playing or download, rather than selecting files for download and secondly to connect to a source for downloading the files, for example.

The Office asserted that Lamkin discloses all of the claimed subject matter within Figure 17, and paragraphs 0027-0028, 0121 and 0462. Applicant traverses. None of the cited portions

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in Lamkin teach making selections of content files on the machine, then connecting the machine to a content source, and lastly executed predefined rules to perform at least one operation on content files associated with the selection of content files, as in claim 19.

Consequently, since Lamkin does not teach all of the limitations of claim 19, Lamkin does not anticipate claims 19-21 and 23-24.
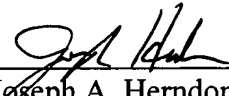
## III. Summary

Applicants respectively submit that in view of the remarks above, all of the pending claims 1-24 are in condition for allowance and such action is respectively requested. The Examiner is invited to call the undersigned at (312) 913-0001 with any questions or comments.

Respectfully submitted,

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